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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/871,125	05/31/2001	Michael W. Pariza	960296.97958	2562

7590 06/06/2005

Bennett J. Berson
Quarles & Brady LLP
1 South Pinckney Street
P O Box 2113
Madison, WI 53701-2113

EXAMINER	
HUI, SAN MING R	

ART UNIT	PAPER NUMBER
1617	

DATE MAILED: 06/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 09/871,125	**Applicant(s)** PARIZA ET AL.	
	Examiner San-ming Hui	**Art Unit** 1617	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 April 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: _____.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attached.
12. ☒ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). 4/18/05
13. ☐ Other: _____.

San-ming Hui
Primary Examiner
Art Unit: 1617

DETAILED ACTION

Continuation of 11)

Applicant's arguments filed April 18, 2005 averring lipoxygenase inhibition as well-known to one of skilled in the art have been considered, but are not found persuasive. As discussed in the office action mailed January 13, 2005, the claims recited functional languages at point of novelty to define the instant method of controlling body fat. It is not clear what agents recited in claim 1. Furthermore, since no agents are recited, the amount recited will not be ascertained. Moreover, Examiner notes that there is no structural-activities relationship disclosed in the specification as to what structure or moieties or functional group would make the compounds as useful to inhibit lipoxygenase and be useful for controlling body fat as recited. Without such information and guidance, one of skilled in the art will be required to perform undue experimentation to test every known compounds to man and ascertain all lipoxygenase inhibitors encompassed by the claims suitable for controlling body fat in order to practice the full scope of the claims. Attention is directed to *General Electric Company v. Wabash Appliance Corporation et al* 37 USPQ 466 (US 1938), at 469, speaking to functional language at the point of novelty as herein employed: "the vice of a functional claim exists not only when a claims is "wholly" functional, if that is ever true, but when the inventor is painstaking when he recites what has already been seen, and then uses conveniently functional language at the exact point of novelty". Functional language at the point of novelty, as herein employed by Applicants, is further admonished in *University of California v. Eli Lilly and Co.* 43 USPQ2d 1398 (CAFC 1997) at 1406:

stating this usage does "little more than outlin[e] goals appellants hope the recited invention achieves and the problems the invention will hopefully ameliorate". Applicants functional language at the point of novelty fails to meet the requirements set forth under 35 USC 112, first paragraph. Claims employing functional language at the point of novelty, such as Applicants', neither provide those elements required to practice the inventions, nor "inform the public during the life of the patent of the limits of the monopoly asserted" *General Electric Company v. Wabash Appliance Corporation et* supra, at 468. Claims thus constructed provide no guidance as to medicaments employed, levels for providing therapeutic benefit, or provide notice for those practicing in the art, limits of protection. Simply stated, the presented claims are an invitation to experiment, not reciting a specific medicament regimen useful for practicing the instant invention.

Applicant further argues that the instant specification disclosing method of screening and specific criteria of lipoxygenase inhibition activity. These arguments are considered, but are not found persuasive. The specification merely defines how to test a compound, provided if the candidate compounds are known, not the compound itself. Since no particular structure of the compounds disclosed, one of skilled in the art would have to assess every compounds known to man in order to practice the full scope of the claims. In other words, although various individual compounds possessing the disclosed lipoxygenase inhibition activity are known to those of skill in the art, no information is provided to guide the skilled artisan to those diverse genera of structurally divergent compounds possessing similar physiological activity. Examiner is unaware of any

nexus, stated in the art, or herein disclosed, attributing the herein envisioned physiological activity to one, or another, structural formula. Simply stated the skilled artisan must employ experimentation to discover compounds possessing these lipoxygenase inhibition activities required to practice the claimed invention.

Applicant's arguments with regard to the rejection under 35 USC 112, second paragraph have been considered, but are not found persuasive. As discussed in office action mailed January 13, 2005, Examiner notes that "BHA" and "BHT" can mean butylated hydroxyanisole and butylated hydroxytoluene respectively. However, they can also mean, for example, bromo-hexanoic acid and bromo-hexyl thiazole. The problem is that the instant specification does not clearly define what these two agents are. Merely giving the acronyms of the herein recited compounds is insufficient for defining the herein claimed invention. The heart of the mater is not whether one of ordinary skill in the art would know whether butylated hydroxyanisole and butylated hydroxytoluene as lipoxygenase inhibitors or not. It is rather applicant recites acronyms "BHA" and "BHT" that could mean different compounds, and thus, the claims are considered vague and indefinite.

No unanswered arguments are seen to be present herein.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to San-ming Hui whose telephone number is (571) 272-0626. The examiner can normally be reached on Mon 9:00 to 1:00, Tu - Fri from 9:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, PhD., can be reached on (571) 272-0629. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

San-ming Hui
Primary Examiner
Art Unit 1617